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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR            | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|---------------------------------|---------------------|------------------|
| 09/929,265      | 08/14/2001  | Willem Marie Julia Marcel Coene | NL000451            | 9634             |

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS  
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BRIARCLIFF MANOR, NY 10510

EXAMINER

WAMSLEY, PATRICK G

ART UNIT PAPER NUMBER

2819

DATE MAILED: 07/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

CM

|                              |                                       |                                     |  |
|------------------------------|---------------------------------------|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/929,265  | <b>Applicant(s)</b><br>COENE ET AL. |  |
|                              | <b>Examiner</b><br>Patrick G. Wamsley | <b>Art Unit</b><br>2819             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 3/1, 5, 6, 7 is/are allowed.
- 6) ☒ Claim(s) 2, 3/2, 4, 8, 9, 10, 11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>05/09/2005</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new grounds of rejection.

### ***Specification***

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 11 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A signal, per se, does not appear to meet the "tangible" requirement of *State Street*. The utility requirement maintains that certain types of mathematical subject matter or algorithms, standing alone, represent nothing more than abstract ideas. Once this subject matter is reduced to some type of practical application, it becomes patentable. The standard for "practical application," has been, and remains, the production of "a useful, concrete and tangible result." *Alappat*, 33 F.3d at 1544. As a signal by itself is not "tangible," claim 11 is rejected as non-statutory.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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Claims 2, 3/2, 4, 8, 9, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Admitted Prior Art, hereafter APA, in view of U.S. Patent 6,507,299 to Nuijten, hereafter Nuijten.

APA discloses run-length limited, hereafter RLL, code sequences, having merging bits for DC control. Unlike independent claims 2, 7, 8, 9, and 11, APA does not detect a polarity of an extracted run-length.

In contrast, Nuijten discloses an arrangement for embedding supplemental data in an information signal using sync patterns. Specifically, Nuijten changes negative polarity samples into positive polarity samples to create a watermark (col. 4, lines 1-3). At the time of the invention, it would have been obvious to one of ordinary skill in the art to have applied Nuijten's teachings to APA. The motivation would have been to provide a watermark in a perceptually invisible manner, as suggested by Nuijten.

Applicant's arguments, filed on 05/09/2005, address limitations found in claims 1, and 7, but are not persuasive regarding broader independent claims 2, 8, and 9.

For claim 3/2, Nuijten's supplemental data, a watermark, is intended to be used for copyright protection of stored data.

For claim 4, Nuijten uses a detected bit stream.

For claim 10, APA discloses the use of RLL codes in CDS and DVDS.

***Allowable Subject Matter***

Claims 1, 3/1, 5, 6, and 7 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:


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the references of record neither reveal nor render obvious the concept of using the polarity of a run-length sequence at a first position along with a bit value of a hidden information signal to modify a parameter reflecting the degree of freedom in the RLL coded sequence such that the polarity of a run-length sequence at a second position following the parameter is the bit value of the hidden information signal.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent 6,853,320 to Hayami et al adds auxiliary information to RLL code words to provide copy protection. U.S. Patent 6,765,739 to Hogan et al places key data immediately after encoded copy protection data. U.S. Patent 6,718,501 to Brody et al shows a copy protected digital audio compact disc. U.S. Patent 6,490,683 to Yamada et al describes an optical disk having an electronic watermark. U.S. Patent 5,699,434 to Hogan discloses a method of inhibiting copying of digital data.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick G. Wamsley whose telephone number is (571) 272-1814. The official facsimile number is (703) 872-9306. An alternate facsimile number, (571) 273-1814, should only be used for unofficial documents.

  
**Patrick G. Wamsley**  
**July 5, 2005**